

REMARKS

Claims 1-8 are pending in the application. Reconsideration and withdrawal of the final rejection are respectfully requested.

Applicants' counsel wishes to thank Examiners Pan and Corsaro for discussing the instant application via telephone on May 31, 2005. The following remarks are submitted to elaborate upon the deficiencies contained in provisional application no. 60/185,923 upon which the Ponce de Leon et al. reference (US 6,211,791) claims the benefit.

As discussed below, the '923 provisional application fails to provide a specification as prescribed by the first paragraph of §112 such that the Ponce de Leon '791 patent is entitled to the benefit of its provisional filing date. Accordingly, the Ponce de Leon '791 patent is effective as a reference only as of its actual U.S. filing date of May 23, 2000. In view of Applicants' previous submission establishing that the presently claimed invention was conceived and reduced to practice prior to Ponce de Leon's actual filing date of May 23, 2000, the Rule 131 reference of Mr. Tokairin effectively removes Ponce de Leon as a reference. As such, claims 1-4 are submitted to be patentable.

Under 35 U.S.C. §111(b)(1), a provisional application "shall include - (A) a specification as prescribed by the first paragraph of §112 of this title; and (B) a drawing as prescribed by §113 of this title." (emphasis added). Of course, §112 requires that "the specification must contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art...to make

and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

Applicants respectfully submit the ‘923 provisional application completely fails to comply with the provisions of 35 U.S.C. §112. Indeed, the specification merely states, in its disclosure, that “the device will be used as...”, “the device is designed to...”, “the device can be connected to...”, and that “the internal mechanism of the device will contain..”. A further section of the ‘923 provisional merely states advantages of the device, without any written description that would provide an enabling disclosure as to how those advantages are achieved.

The Ponce de Leon ‘791 patent, by contrast, recites in claim 1 the following:

1. An apparent temperature monitor and alarm for a monitored space comprising:

a) a temperature sensor generating a first electrical signal corresponding to a temperature level within the monitored space;

b) a humidity sensor for generating a second electrical signal corresponding to a relative humidity level within the monitored space;

c) a central processor for utilizing the first and second electrical signals generated by said sensors to calculate the level of apparent temperature according to a predetermined formula;

d) a transmitter for transmitting said first and second electrical signals from said temperature sensor and from said humidity sensor to said central processor; and

e) an alarm in communication with said central processor for alerting health and safety personnel of life or health threatening conditions in the monitored space.

As claimed, the apparent temperature monitor and alarm requires a temperature sensor generating a first electrical signal corresponding to a

temperature level within the monitored space, a humidity sensor for generating a second electrical signal corresponding to a relative humidity level, a transmitter for transmitting the first and second electrical signals to a central processor, and a central processor for utilizing the signals to calculate the level of apparent temperature according to a predetermined formula.

As just one illustrative example, nowhere does the '923 provisional application describe even a central processor, let alone one that calculates according to a predetermined formula. Indeed, no formula is given in the '923 provisional application, nor are any of the interworkings of the various components, including their connections, described in the '923 provisional. A review of the USPTO's own MPEP Guidelines readily confirms that the '923 provisional is deficient (MPEP §2163, 2163.01-.03). See, e.g. *In re Wilder*, 736 F.2d 1516, 1521 (Fed. Cir. 1984) (affirming a rejection for lack of written description because the specification does "little more than outline goals Appellants hope the claimed invention achieves and the problems the invention will hopefully overcome").

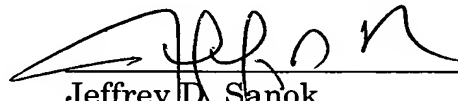
In view of the foregoing, Applicants respectfully submit the Ponce de Leon '791 patent is not entitled to the benefit of its provisional application filing date. Accordingly, Applicants' prior submission removes Ponce de Leon '791 patent as a reference and, hence, claims 1-4 should therefore be patentable. An early notice to that effect is solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #080306.50888US).

Respectfully submitted,

July 5, 2005



Jeffrey D. Sanok
Registration No. 32,169

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844

JDS:pct